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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,816	09/22/2003	John Phenix	14846-21	2173

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EXAMINER	
RADTKE, MARK A	

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,816	PHENIX, JOHN	
	Examiner	Art Unit	
	Mark A. Radtke	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/22/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "until there are no more methods to decompose" in step (d). There is insufficient antecedent basis for this limitation in the claim. There is no step of "decomposing".

5. Claim 2 recites the limitation "the differences" in line 2. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 9 recites the limitation "the get...() methods" in line 2. There is insufficient antecedent basis for this limitation in the claim. Get methods are inherent to JavaBeans, but not Java objects in general.

7. Claim 10 recites the limitation "defining a plurality of function items" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is no step of "defining" in claims 1 or 2.

8. Claims 4-5 and 9 recite the limitation "said object-oriented language" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites "an object-oriented operating system".

9. All other rejected claims are rejected because they depend from rejected claims.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites a "method for comparing a first object and a second object in an object-oriented operating system", which presents an "abstract idea" which does not necessarily require a technology. A claim must not be directed merely to an abstract idea, but must instead be tied to a computer, environment, or machine, which would result in a practical application producing a concrete, useful and tangible result. The claimed method is directed towards a computer program *per se* and thus is non-statutory.

Furthermore, claim 1 fails to produce a useful, concrete and tangible result. The final step of "recursively performing" steps is simply a step in an algorithm and not a useful result. Typical results include "storing" or "displaying" a result. The "document" of claim 2 is a useful result, but it is intangible because it is only "generated" and not stored or displayed to a user. The method lacks concreteness because there is no "else" corresponding to the "if" of step (b). If the determination in step (a) is true (the objects are equal), the algorithm fails because step (c) would lack antecedent basis for "the one or more methods". Examiner recommends amending claim 1 to incorporate claim 2 and changing "generating" to --generating and storing-- or --generating and displaying-- the report, and correcting optional recitations. This will not overcome the

previous grounds for rejection ("a computer program *per se*"), but will produce a useful, concrete and tangible result.

Claims 2-10 are rejected under 35 U.S.C. 101 because they are dependent from the rejected independent claim 1.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason (U.S. Pat. No. 6,826,716) in view of Shirazi ("Java Performance Tuning", Section 7.5, "Recursion and Stacks", published September 2000, available online at: http://proquest.safaribooksonline.com/0596000154).

As to claim 1, Mason teaches a method for comparing a first object and a second object in an object-oriented operating system (see Abstract) comprising the steps of:

(a) determining whether the first object (see figure 4, element 412) is equal to the second object (see figure 4, element 406) (See column 12, lines 20-23. Deployment descriptors can be compared directly. XML tags are nodes in a tree, thus objects.);

(b) obtaining one or more methods from said first object and said second object if said objects are not equal (see column 12, lines 40-46);

(c) determining whether the one or more methods from said first object are equal to the one or more methods from said second object (see column 12, line 45, "reporting (**444**)"); and

(d) performing steps (b) and (c) until there are no more methods to decompose (see column 8, line 47, "For Each method-permission element").

Mason does not explicitly teach recursively performing steps.

Shirazi teaches recursively performing steps (see pages 1-2).

Therefore, it would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have modified Mason by the teaching of Shirazi because "you can convert a recursive method into an iterative method" (see Shirazi, Section 7.5, lines 3-4).

As to claim 2, Mason, as modified, teaches generating a document comprising the differences between methods (See column 12, line 45, "reporting (**444**)" and see column 15, lines 18-20).

As to claim 3, Mason, as modified, teaches wherein step (b) further comprises storing names of said methods (see column 13, lines 64-65, "VAR METHODNAME"), step (c) comprises storing indicia representing the determination whether the methods are the same (see column 14, line 7, "For each match found") and step (e) comprises

generating a document from said stored names and indicia (see column 15, line 21, "e1.printStackTrace()").

As to claim 4, Mason, as modified, teaches wherein said object-oriented language comprises JAVA (see Abstract) and step (a) comprises running an equality method on said objects (See Examiner's comments regarding claim 1. Testing whether objects are equal implies running an equality method).

As to claim 5, Mason, as modified, teaches wherein said object-oriented language comprises JAVA (see Abstract) and step (c) comprises running an equality method on said objects (See Examiner's comments regarding claim 1. Testing whether methods are equal implies running an equality method).

As to claim 9, Mason, as modified, teaches wherein said object-oriented language comprises JAVA (see Abstract) and step (b) comprises invoking the get...() methods of each object (JavaBeans consist of publicly-exposed set and get methods).

As to claim 10, Mason, as modified, teaches wherein defining a plurality of function items comprises defining a function for each of said plurality of function items (see column 13, line 62, "For Each <method-permission> element").

14. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason as modified as applied to claim 2 above, and further in view of Keller et al. (U.S. Pat. No. 6,662,312).

As to claim 6, Mason, as modified, does not explicitly teach further including the step of:

(f) transforming the document into human-readable form.

Keller et al. teaches (f) transforming the document into human-readable form (see figure 4).

It would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have modified Mason as modified by the teaching of Keller et al. because Mason "can potentially generate many different kinds of test" (see Mason, column 15, lines 32-33) and the final step of Mason is "reporting" (see Mason, figure 4, element 444).

As to claim 7, Mason, as modified, teaches human-readable form (see Examiner's comments regarding claim 6).

Mason, as modified, does not expressly teach comprising XML.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The determination of human-readable would be performed the same regardless of file format. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms

of patentability, (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art at the time the invention was made to display information to a human operator based on any type of file format, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

As to claim 8, Mason, as modified, teaches wherein transforming the document into human-readable form comprises transforming the document into a web page (see column 6, lines 62-67 and see column 10, lines 12-14).

Additional References

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to object comparison in general:

USPN 5,974,254, assigned to Ray Hsu.

"Reflections on Java, Beans, and relational databases", Sandor Spruit, Published September 1997, available online at http://www.javaworld.com/javaworld/jw-09-1997/jw-09-reflections.html

Conclusion

16. Any inquiry concerning this communication or earlier communications should be directed to the examiner, Mark A. Radtke. The examiner's telephone number is (571) 272-7163, and the examiner can normally be reached between 9 AM and 5 PM, Monday through Friday.

If attempts to contact the examiner are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (800) 786-9199.

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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1 September 2006